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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,562	11/01/2000	William C O'Neil, Jr.	TFFUND-04809	3102
23535	7590	04/27/2004	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/703,562

Applicant(s)

O'NEIL, JR. ET AL.

Examiner

Donald L. Champagne

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-35 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-35 and 37-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 17 February 2004 have been fully considered but they are not persuasive. The arguments are discussed at para. 6, 8, 10 and 13 below.

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-8, 10-12, 14-18, 22, 24-25, 27-30, 32-35, 37-40, 42-45 and 48 are rejected under 35 U.S.C. 102(b) as anticipated by Lidman.
5. Lidman teaches (independent claims 1, 17, 24, 33, 35 and 43) a method and a system, the method comprising: providing a member, at least one higher education account, and at least one merchant offering discount *coupons*, which reads on a rebate; calculating (col. 3 lines 5-6) said coupon rebate on purchases made by at least said member from at least one merchant; and crediting said at least one higher education account (col. 1 lines 26-46).
6. Applicant argues (p. 10, second para.) that Lidman does not teach the rebate-calculating step of claims 1, 17 and 24. Applicant acknowledges that Lidman teaches **summing** the values of presented coupons, but goes on to argue that "that is not the same as calculation of a rebate on purchases". Calculating a rebate on purchases entails calculating, and it entails a rebate on purchases. As noted in para. 5 above, the reference teaches coupons

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applied to purchases, which reads on a rebate on purchases. Applicant argues that summing the values of the coupon rebates does not comprise calculation, but that is unsupported. One of ordinary skill in the art would readily understand that summing is calculating: The Merriam-Webster Online Dictionary defines "sum (verb)" as "to calculate the sum of" (emphasis added).

7. For claims 17 and 35, *clearinghouse 30* (col. 4 lines 29-33) reads on "a rebate network manager" and "a tracking entity"; the *cash register 110* reads on "a processor"; and the *bank communication system 120* (col. 2 line 67 to col. 3 line 3) reads on the "computer network".
8. Applicant argues (p. 11-12, items B and C) that the rejection incorrectly identified the teaching of a "network rebate manager" and a "tracking entity" in Libman. Applicant notes that the terms "network rebate manager" and "tracking entity" are defined in the specification (p. 6, lines 14-20). The applicant is correct, and para. 7 above has been revised to identify the *clearinghouse 30* as the entity in Libman that serves as a network rebate manager and as a tracking entity, as defined in the specification.
9. For claims 24, 33 and 43, Lidman teaches college and educational savings accounts (col. 1 lines 26-31 and 55-56), which reads on member higher education accounts, said accounts comprising a *bank account 50* (col. 2 lines 51-52), and a *conventional bank communication system 120 to transfer funds between bank accounts electronically* (col. 3 lines 1-3), which reads on a memory device comprising said member higher education accounts and connected to a processor by a computer network.
10. Applicant argues (p. 12-13, item D) that the rejection did not correctly identify a teaching of a memory device comprising member higher education accounts. Para. 9 above has been revised to more clearly explain the teaching.
11. Lidman also teaches at the citations given above claims 2, 4-5, 7-8, 10-11, 15, 28, 30, 37-38, 40, 42, 45 and 48.
12. Lidman also teaches at the citations given above claims 16, 29, 39 and 44, where the *bank 130* that is the custodian of *customer account 50* reads on a registration organization, which inherently must be paid (receives a portion of said rebate).

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13. Applicant argues (p. 13, item E) that the rejection did not correctly identify a teaching of an organization facilitating registration. Para. 12 above has been revised to more clearly explain the teaching. Opening a bank account of any sort necessarily entails registration.
14. Lidman also teaches: a college fund savings account (claims 6, 18, 22, 25 and 34, at col. 1 line 26-31 and 55); claims 12 and 27 (col. 3 line 38); and claims 14 and 32 (col. 2 line 43, which teaches a *cash register 110*, which reads on an on-site merchant).
15. Claims 9, 13, 19-21, 23, 26, 31, 41 and 46-47 are rejected under 35 U.S.C. 103(a) as obvious over Lidman.
16. Lidman does not teach that (claims 9, 26 and 47) the rebate is from 1% to 30% of the price of said purchases or (claims 13, 31, 41 and 46) purchases made on-line. Official notice of this common knowledge or well-known in the art statement was taken in the last Office action (para. 17 of paper No. 6, mailed 15 December 2003). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)
17. Lidman does not teach (claims 19-20) a student loan payment account, (claim 21) an educational IRA or (claim 23) a college charitable contribution account. Because these accounts support education, and would therefore attract business to participating merchants, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these kinds of accounts to the teachings of Lidman.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
21. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. A reference is available for all that it teaches. Applicant is responsible for reading the entire reference. An applicant does not generally have recourse to reconsideration merely because the examiner failed to correctly cite the correct part(s) of the reference. However, in this case, the examiner will give special consideration to any after-final arguments that the applicant submits concerning those parts of the last rejection that were corrected herein, namely para. 7, 9 and 12 above. For applicant's convenience, a new marked copy of the reference is attached and thereby made of record. This special after-final consideration does not apply to any other argument or to amendments.

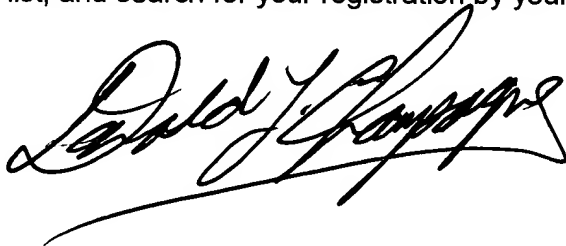
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24. Applicant may have other arguments considered and amendments entered by filing an RCE.

It is the examiner's practice to search the specification of RCE filings for allowable matter.

However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing an RCE will result in an indication of allowable matter.

25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

22 April 2004